

REMARKS

Claims 1-2, 5-7, 9-21 and 23 are pending in the present application. Claim 1 has been amended as set forth above. It is respectfully submitted that the pending claims define allowable subject matter.

Claims 1, 2, 5, 9 and 23 were rejected under 35 U.S.C. 103 as being unpatentable over United States Patent No. 5,734,694 ("Khutoryansky").

Claims 6, 7 and 10-21 were rejected under 35 U.S. 103 as being unpatentable over Khutoryansky in view of United States Patent Nos. 5,717,732 ("Tam") and 5,412,702 ("Sata").

With respect to the rejection of claims 1, 2, 5, 9 and 23 under 35 U.S.C. 103 as being unpatentable over Khutoryansky, the Applicant has amended claim 1 to recite "positioning said detector and x-ray tube at said second detector and x-ray tube preparation positions, respectively, after said acquiring a first x-ray image step." In addition to the arguments already set forth by the Applicant during the prosecution of the present application, Khutoryansky does not teach or suggest the added limitation.

Khutoryansky, at Column 8, lines 7-11, states the following:

Once the predetermined exposure time has been reached, implying that the tube and bucky travel have reached the end of the selected sweep angle, x-ray exposure is terminated. *After each tomographic exposure, the system returns to the CENTER position.* (emphasis added)

Khutoryansky describes a system in which the tube and bucky return to the CENTER position *after* each individual x-ray exposure. Khutoryansky does not, however, teach or suggest "positioning [a] detector and x-ray tube at [a] second detector and x-ray tube preparation positions, respectively, after acquiring a first x-ray image." Thus, Khutoryansky does not render claim 1 obvious. The Applicant respectfully submits, therefore, that claim 1 should be in condition for allowance.

The Applicant now turns to the rejection of Claims 6, 7 and 10-21 under 35 U.S. 103 as being unpatentable over Khutoryansky in view of Tam and Sata. Initially, the Applicant notes that claims 6 and 7 depend from claim 1 and include all the limitations of claim 1. Because Khutoryansky does not teach or suggest all the limitations of claim 1, as discussed above and previously during prosecution of this application, the Applicant

respectfully submits that the combination of references does not render claims 6 and 7 obvious.

The Manual of Patent Examining Procedure (MPEP), at 2143, states the following:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Further,

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

The MPEP at 2142 states the following:

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In addition to the arguments already set forth by the Applicant during the prosecution of the present application, the Applicant respectfully submits that a person having ordinary skill in the art would not be motivated to combine Khutoransky with Tam and Sata. Rather, this combination represents "impermissible hindsight."

In *Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988), the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been

obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

During the prosecution of the present application, the Examiner noted the following:

Khutoryansky does not detail the structure of his detector, and it would have been obvious to employ therefor any known detector such as the digital detector taught by Tam in order to provide real time display. Sata teaches an x-ray tomography equipped with a display 40 for simultaneously showing multiple tomographic views, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to equip the Khutoryansky with such means to speed up medical diagnosis.

However, MPEP 2143.01 states the following:

A statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)...

The Applicant respectfully submits that the Examiner is merely picking and choosing particular elements among different prior art references.

As discussed previously, Khutoryansky discloses “a universal radiographic apparatus that allows an operator to select between *conventional* radiographic mode and linear tomographic mode.” See Abstract (emphasis added). Further, Khutoransky, at Column 2, lines 30-34, states the following:

In accordance with the present invention, a universal radiographic room provides the capability to conduct *conventional* radiographic examination or linear tomographic examinations using a relatively economical and compact arrangement that incorporates many features particularly attractive to the practitioner. (emphasis added)

Khutoransky, in effect, defines both conventional radiographic examination and linear tomographic examination in the Background, at Column 1, lines 16-29:

The nature of conventional radiographic examination is well known.... Linear tomography, where both the X-ray tube and X-ray *film* are constrained to straight-line motion is perhaps the most common and easiest to practice variant of tomography. (emphasis added)

Khutoransky is directed at a universal imaging room that may image a patient using both of these *conventional* techniques. That is, Khutoransky merely combines the conventional techniques of film-based, conventional radiography and film based linear tomography. For example, Khutoransky states in the Summary of the Invention at Column 1, lines 49-53:

These needs and other are satisfied by the universal radiographic room of the present invention, in which an x-ray generator equipped with a generator control that selects between *conventional* radiographic and linear tomographic modes operation is provided.

As mentioned above, Khutoransky defines radiography and linear tomography to be conventional film-based techniques in the Background. However, Khutoransky does not teach or suggest a digital detector, or digital radiography or tomography.

As discussed previously during the prosecution of the present application, neither Khutoransky nor Sata teach or suggest acquiring a series of images with a digital x-ray detector and displaying each of the images in the series as each image is acquired. Also, the Applicant respectfully maintains that Sata clearly suggests, at Column 2, lines 32-39, that the images are *not* displayed as they are acquired. That is, Sata teaches away from “displaying images simulataneously as each image in said series of images in acquired.” Thus, the Applicant respectfully submits that no motivation exists to combine Khutoryansky and Sata in this manner.


Further, as discussed previously during the prosecution of the present application, no suggestion is made by Khutoryansky to replace the film-based systems disclosed in Khutoryansky with a digital detector, such as the digital detector of Tam, for the purpose of providing a real time display, or for any other purpose. Thus, the Applicant respectfully maintains that no motivation exists to combine Khutoryansky and Tam in this manner.

In combining these three references together, the Examiner has merely picked and chosen among isolated, individual elements of assorted prior art references to re-create the Applicant's claimed invention. The Applicants respectfully submit that there is no teaching or suggestion in these references to support their use in the particular claimed combination. The Applicant respectfully submits (and maintains) that claims 6-7 and 10-21 are in condition for allowance.

In light of the above, the Applicant requests reconsideration of the application and looks forward to working with the Examiner to resolve any remaining issues in the application.

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the Applicant. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,


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Date: April 14, 2003

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